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Brief

D-1113

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)
Jeffery M. Enright)
Serial No.: 09/439,718) Art Unit 3622
Confirm. No.: 2011)
Filed: November 12, 1999) Patent Examiner
Title: Cash Dispensing Method for) Donald L. Champagne
Self-Service Facility such as)
Motor Fuel Dispensing Facility)

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GROUP 3600

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated November 4, 2002 is acknowledged.

Grouping of Claims

The Answer (at page 2) indicates that the Office does not agree with the statement in the Appeal Brief that the claims do not stand or fall together. The Appellants respectfully disagree. The Grouping of Claims section in the Appeal Brief is correct.

The Appeal Brief (at page 4) includes a Grouping of Claims section which states that "No groups of claims stand or fall together." Thus, the Appeal Brief includes a proper statement that the claims do not stand or fall together. The Appeal Brief (in the Argument section thereof) also explains why the claims are separately patentable.

Thus, the Appeal Brief includes both a proper statement that the claims do not stand or fall together and presents arguments why the claims are separately patentable. It follows that the Answer incorrectly ascertains the Grouping of Claims section of the Appeal Brief.

Furthermore, where an Appeal Brief includes only one of either (a) a statement that the claims do not stand or fall together or (b) presents arguments why the claims are separately patentable, then the Appellants are to be notified of a noncompliance as per 37 C.F.R. § 1.192(d). Note MPEP § 1206 (page 1200-11, col. 1, first paragraph; August 2001 version). The Answer admits that the Appeal Brief includes a statement that the claims do not stand or fall together. However, Appellants were not notified of any noncompliance. Nor were Appellants given any appropriate time period to correct any alleged defects in accordance with 37 C.F.R. § 1.192(d).

Thus, it must be concluded that the Appeal Brief (including the Grouping of Claims section thereof) is in compliance with 37 C.F.R. § 1.192(c). Appellants respectfully request that the Answer's incorrect allegations regarding the Grouping of Claims section of the Appeal Brief be disregarded.

Reply to additional comments in the Answer

The Answer includes a "Response to Argument" section (beginning at page 6, last paragraph) which includes additional comments. Appellants respectfully submit that most of the issues mentioned in this section have already been addressed in the Appeal Brief. Thus, please note the Appeal Brief for more detailed arguments.

Claim 38

The Office is reminded that claims 38-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by Phillips, not (as the Answer attempts to argue) under 35 U.S.C. § 103(a).

The Answer alleges that a "teaching of a difference between a merchandise charge and an amount of cash accepted is inherent." The Appellants respectfully disagree.

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used

or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). Furthermore, an assessment of basic knowledge and common sense by the Office that is not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

The Answer (at page 7, paragraph 3) alleges concerning Phillips that "one of these apparatuses" (i.e., one of the fuel pump and the vending machine) can accept cash and that "one of these apparatuses" (i.e., one of the fuel pump and the vending machine) can have a printer to generate a receipt bearing a code. However, the Answer does not allege that the same apparatus (i.e., either the fuel pump or the vending machine) accepts cash and prints a receipt bearing a code. That is because in Phillips the same apparatus does not both accept cash and print a receipt bearing a code. Phillips does not explicitly or inherently teach "generating a code" which corresponds to a difference between a merchandise charge and an amount of cash accepted. Phillips does not anticipate claim 38.

The Answer admits (page 7, line 18) that in Phillips "the joint purchase is made with a credit card" (i.e., joint purchase of fuel and vending machine item). The Answer then alleges that it would be advantageous (i.e., obvious) "if it took a ten dollar bill for the joint purchase" (instead of a credit card). That is, the Answer alleges that it would be obvious for the fuel pump in Phillips to take cash instead of only a credit card as specifically taught. However, such allegations are not pertinent because the rejection is under 35 U.S.C. § 102(e), not under 35 U.S.C. § 103(a).

Furthermore, the Answer ignores the direct teachings of Phillips which are to enable a

customer to purchase goods from the vending machine via the same credit card transaction as is used with the fuel pump (col. 3, lines 13-21 and 39-40). Phillips' teachings are specifically to provide for vending machine goods to be purchased (along with fuel) without the need of cash (e.g., col. 3, lines 19-21; col. 24 lines 17-20). Phillips does not anticipate claim 38 (and also teaches against the attempted allegations of obviousness).

Claims 1 and 40

On page 8, at lines 13-20, the Answer further alleges that Phillips' "teaching is broader than acknowledged." However, the Answer is absent a showing of this alleged "broader" teaching. Instead the Answer alleges that the bottom of page 11 of the Appeal Brief omits parts of Phillips with regard to col. 3, lines 1-7. However, it is unclear how the Appeal Brief could omit parts of Phillips when the Appeal Brief section did not directly quote Phillips, as apparently alleged.

Nevertheless, the Answer then quotes Phillips at col. 3, lines 1-7 with omissions. That is, Phillips at col. 3, lines 1-7 states "a user would be prompted to purchase goods from a second good dispensing apparatus 3, such as a vending machine 3 vending canned drinks for example, through the course of normal operation with a self service fuel dispensing credit card operated pump 1 on a pump island of a vehicle fueling facility." The Answer's omitted parts have been underlined, especially the part about the credit card operated pump. That is, even if the second goods dispensing apparatus was some type of device other then a vending machine, it would still be associated with a credit card transaction conducted at a fuel pump (i.e., specifically without the need for cash).

On page 8, last paragraph, the Answer alleges that a "key" feature to the rejection of claims 1 and 40 is Gatto's "pay inside" and "cash back." The Appellants respectfully disagree. As discussed in more detail in the Appeal Brief, Phillips/Gatto lack the "recited" features. Nor would it have been obvious to have located Phillips' second goods dispensing apparatus (i.e., vending machine) at a facility remote from the pump island, especially when Phillips specifically teaches that his invention solves the prior art problems by locating the vending machine "on a pump island" of a vehicle fueling facility (col. 2, lines 62-67; col. 7, lines 32-35).

The Answer (on page 8) further alleges that the Appellants argue that the meaning of Gatto's terms "pay inside" and "cash back" are not clear. The Appellants respectfully disagree. The Answer attempts to change the disclosed teaching of Gatto's terms for "common terms whose meaning is clear to lay people as well as to those of ordinary skill in the retailing art." However, the Answer provides no evidence of record of this allegedly well known, common "clear" meaning. To present a valid rejection the evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

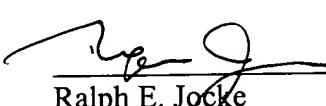
The Answer (on page 9) also alleges that the Appeal Brief "fails to address the rejections" regarding the dependent claims. The Appellants respectfully disagree. Appeal Brief pages 18-29 and 32-33 address and provide arguments against the rejections of the dependent claims. The Office has not established a *prima facie* showing of obviousness. The Appellants are not required to prove patentability. Contrarily, it is the Office which must establish a *prima facie*

case of obviousness under the law. Otherwise, the Office is legally required to issue a patent. The Action's allegation that the Appeal Brief "fails to address the rejections" is a further example of the Office's unfair interpretation of the issues and is reflective of all the rejections on appeal.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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